

Remarks

Claims 1-54 were rejected. In view of the remarks set forth below reconsideration is respectfully requested. No new matter has been entered as a result of this response.

I. General Request for Clarification and Re-Submission of the Office Action

As a general matter, the present rejection of claims 1-54 is incomplete or at best fails to convey a sufficient explanation for Applicants to fully understand the basis of the Examiner's rejection and has not been presented in a form consistent with the Manual of Patent Examining Procedure (MPEP) to enable Applicants to fully address the merits of the rejection. Thus, absent a proper explanation, Applicants cannot in good faith ascertain whether the rejection properly sets forth a prima facie case of obviousness. The basis for this position is as follows:

As best understood, the rejection recited on page 2 is not a single rejection, but rather four separate rejections based on 35 USC § 103 in which each of the four references stands as a separate "one reference" obviousness rejection taken in combination with "well known" prior art or common knowledge in the art in accordance with MPEP 2144.03. However, the Examiner has failed to provide any breakdown identifying those features in each of the claims that are found in the references and those features in each of the claims that the Examiner believes to be "well known". **Therefore, Applicant would request that the Examiner identify each feature of each claim believed to be "well known" and, in accordance with MPEP 2144.03, Applicant traverses the assertion that these features are "well known" and requests that the Examiner "cite a reference in support of his or her position."** It should be appreciated that the absence of any explanation to distinguish those features of the claims believed to be found in the cited references from those features believed to be "well-known" obscures the Examiner's true reasoning for the rejection. Such reasoning is further obscured by the failure of the Office Action to meet the general requirements for a proper rejection as follows:

1. All of the rejections violate MPEP 2141.02 by distilling claims 1-54 down to a single “inventive concept” or “gist” and disregards consideration of each of the claims “as a whole”. The only comparison of the cited prior to claims 1-54 was not to the features of claim 1, but rather an “inventive concept” provided by the Examiner in the second paragraph of page 3 of the Office Action. In contrast to the requirements of MPEP 2141.02, it is the Examiner’s contention that all 54 claims provide a single feature defined as an “identification, verification or creation of an identification of a claim number for tracking purposes.” In addition, this single inventive concept does not even accurately describe the features of claim 1. Thus, all of the claims have been rejected on the basis of an inventive concept which does not accurately describe any of the 54 pending claims. By violating MPEP 2141.02, the Examiner has totally disregarded the features found in the 54 claims of the present application and by improperly comparing the cited references to an improper “inventive concept” rather than the claim features found in the claims has further obscured any meaningful understanding of the rejection.

2. The rejections of claims 2-54 violate MPEP 707.07(d) as being an improperly expressed rejection. “An omnibus rejection of the claim ‘on the references and for the reasons of record’ is stereotyped and usually not informative and should therefore be avoided.” The basis for the rejection of claims 2-54 is the type of rejection that MPEP 707.07(d) was designed to prevent and the absence of reasoning by the Examiner fails to provide Applicant with any basis for understanding the Examiner’s grounds for rejection.

Accordingly, if there is a genuine rejection of claims 1-54 that the Examiner believes should be maintained then Applicants respectfully request the Examiner provide a clearer mapping of the cited art of record to each of the claim elements found in the 54 pending claims as well as provide references for those elements, presently unknown, that the Examiner believes are “well Known”.

II. Rejection under 35 USC § 103 of Claim 1 in view of Barr et al.

As best understood in view of the above general remarks, claim 1 was rejected as being obvious by Barr et al., US Patent No. 5,182,705, in view of “well known” prior art. Applicants traverse the rejection as being improper on grounds that the rejection fails to establish a prima facie case of obviousness as the rejection fails to set forth what features of Barr are being modified by “well known” prior art and fails to teach or suggest all the claim limitations.

MPEP 2143 states:

To establish a prima facie case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As indicated above the Office Action fails to identify which of the features of claim one, it is contended are found in Barr et al. and which features are found in “well known” art. Claim 1 includes two elements, namely, “software accessed at a provider computer” and a “worker’s compensation verification system”. Upon reviewing Barr, Applicant could not find either of these elements as they are featured in claim 1. For example, there was no teaching or suggestion of “software accessed at a provider computer” that “sends an electronic claim number request” nor any teaching of a “worker’s compensation claims verification system” that “produce[s] an indication of the lack of the worker’s compensation claim number.” It is noted that the latter feature is not even covered by the Examiner’s expression of the inventive concept found on page 3, paragraph 2 of the Office Action. If these features are found in Barr then Applicant requests

that the Examiner provide a citation identifying each of these features. Otherwise, reconsideration and withdrawal of the rejection is respectfully requested.

III. Rejection under 35 USC § 103 of Claim 1 in view of Johnson et al.

As best understood in view of the above general remarks, claim 1 was rejected as being obvious by Johnson et al., US Patent No. 4,987,538, in view of “well known” prior art.

Applicants traverse the rejection as being improper on grounds that the rejection fails to establish a prima facie case of obviousness as the rejection fails to set forth what features of Johnson are being modified by “well known” prior art and fails to teach or suggest all the claim limitations.

MPEP 2143 is stated Supra.

As indicated above the Office Action fails to identify which of the features of claim one it is contended are found in Johnson et al. and which features are found in “well known” art. Claim 1 includes two elements, namely, “software accessed at a provider computer” and a “worker’s compensation verification system”. Upon reviewing Johnson, Applicant could not find either of these elements as they are featured in claim 1. For example, there was no teaching or suggestion of “software accessed at a provider computer” that “sends an electronic claim number request” nor any teaching of a “worker’s compensation claims verification system” that “produce[s] an indication of the lack of the worker’s compensation claim number.” If these features are found in Johnson then Applicant requests that the Examiner provide a citation identifying each of these features. Otherwise, reconsideration and withdrawal of the rejection is respectfully requested.

IV. Rejection under 35 USC § 103 of Claim 1 in view of DiRienzo

As best understood in view of the above general remarks, claim 1 was rejected as being obvious by DiRienzo, US Patent No. 6,343,310, in view of “well known” prior art. Applicants traverse the rejection as being improper on grounds that the rejection fails to establish a prima

facie case of obviousness as the rejection fails to set forth what features of DiRienzo are being modified by “well known” prior art and fails to teach or suggest all the claim limitations.

MPEP 2143 is stated Supra.

As indicated above the Office Action fails to identify which of the features of claim one it is contended are found in DiRienzo and which features are found in “well known” art. Claim 1 includes two elements, namely, “software accessed at a provider computer” and a “worker’s compensation verification system”. Upon reviewing DiRienzo as a whole and specifically at Col. 22, Line 7- Col. 23, line 53, Applicant could not find either of these elements as they are featured in claim 1. For example, there was no teaching or suggestion of “software accessed at a provider computer” that “sends an electronic claim number request” nor any teaching of a “worker’s compensation claims verification system” that “produce[s] an indication of the lack of the worker’s compensation claim number.” If these features are found in DiRienzo then Applicant requests that the Examiner provide a citation identifying each of these features. Otherwise, reconsideration and withdrawal of the rejection is respectfully requested.

V. Rejection under 35 USC § 103 of Claim 1 in view of Tarter et al.

As best understood in view of the above general remarks, claim 1 was rejected as being obvious by Tarter et al., US Patent No. 5,704,044, in view of “well known” prior art. Applicants traverse the rejection as being improper on grounds that the rejection fails to establish a prima facie case of obviousness as the rejection fails to set forth what features of Tarter are being modified by “well known” prior art and fails to teach or suggest all the claim limitations.

MPEP 2143 is stated Supra.

As indicated above the Office Action fails to identify which of the features of claim one it is contended are found in Tarter et al. and which features are found in “well known” art. Claim 1 includes two elements, namely, “software accessed at a provider computer” and a “worker’s

compensation verification system”. Upon reviewing Tarter, Applicant could not find either of these elements as they are featured in claim 1. For example, there was no teaching or suggestion of “software accessed at a provider computer” that “sends an electronic claim number request” nor any teaching of a “worker’s compensation claims verification system” that “produce[s] an indication of the lack of the worker’s compensation claim number.” If these features are found in Tarter then Applicant requests that the Examiner provide a citation identifying each of these features. Otherwise, reconsideration and withdrawal of the rejection is respectfully requested.

VI. Rejection under 35 USC § 103 of Claims 2-54

The Office Action presently does not include sufficient information to readily ascertain the basis for rejecting claims 2-54 in view of the defects recited above. Applicant requests that the Examiner either provide a proper grounds for rejection or allow these claims. As no proper grounds for rejection has been recited against these claims, Applicant points out that a second office action “Final Action” would be premature.

VII. Summary

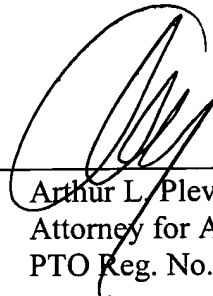
Applicant believes that all the Examiner's rejections have been addressed and overcome. None of the references, either alone, or in combination, anticipate or render obvious the invention claimed in claims 1-54. Accordingly, reconsideration and withdrawal of the rejections is respectfully requested.

VIII. Fees

No fees are believed required for the filing of this Response. However, if there are any fees due and owing because of this Amendment and Response, or for other matters regarding this application, the Examiner is authorized to charge such fees to Duane Morris LLP, Deposit Account No. 50-2061.

Respectfully submitted,

By: _____


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